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4 UNITED STATES DISTRICT COURT
5
6 EASTERN DISTRICT OF WASHINGTON

7 CORPORATION OF GONZAGA)
8 UNIVERSITY,)

NO. CV-14-0093-LRS

9 Plaintiff,)

**ORDER ON GONZAGA'S MOTION
FOR [PARTIAL] SUMMARY
JUDGMENT**

10 -vs-)
11)

12 PENDLETON ENTERPRISES, LLC,)
13 a Washington LLC; PENDLETON)
14 BROADCASTING, INC., a)
15 Washington Corporation; and)
16 JAMIE PENDLETON, an)
individual and a resident of)
the State of Washington,)

17 Defendants.)
18)

19 **BEFORE THE COURT** is Plaintiff Corporation of Gonzaga
20 University's ("Gonzaga") Motion For Summary Judgment¹ (ECF No.
21 21) filed on July 16, 2014. Oral argument was held on
22 September 4, 2014 in Spokane, Washington. Defendants opposed
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24

25 ¹The motion is a partial summary judgment as Gonzaga's
26 motion seeks to have a ruling only on the alleged violation of
§43(a) of the Lanham Act (15 U.S.C. §1125(a)).

1 the motion (ECF No. 26). The court took Gonzaga's motion
2 under advisement at the conclusion of the hearing.

3 4 **DISCUSSION**

5 **A. Introduction**

6 Plaintiff Gonzaga brought an action against Defendant
7 Pendleton Enterprises, LLC, Pendleton Broadcasting Inc., and
8 Jamie Pendleton (collectively referred to as "Defendants"),
9 alleging violations of the Lanham Act, trademark infringement
10 (federal, state and common law), Washington Consumer
11 Protection Act, and unfair competition. Gonzaga moved for
12 partial summary judgment on its §43(a) Lanham Act (15 U.S.C.
13 §1125(a)) claim. Plaintiff asserts a commercial interest in
14 preventing unauthorized use of Gonzaga trademarks because such
15 use will allegedly create confusion concerning Plaintiff's
16 endorsement of Defendants' bar and radio station related
17 activities, products and services.
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21 **B. Legal Standard**

22 A party may move for summary judgment on a "claim or
23 defense" or "part of ... a claim or defense." Fed.R.Civ.P.
24 56(a). Summary judgment is appropriate when there is no
25 genuine dispute as to any material fact and the moving party
26

1 is entitled to judgment as a matter of law. *Id.*

2 A party seeking summary judgment bears the initial burden
3 of informing the court of the basis for its motion, and of
4 identifying those portions of the pleadings and discovery
5 responses that demonstrate the absence of a genuine issue of
6 material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323,
7 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). Material facts are
8 those that might affect the outcome of the case. *Anderson v.*
9 *Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91
10 L.Ed.2d 202 (1986). A dispute as to a material fact is
11 "genuine" if there is sufficient evidence for a reasonable
12 jury to return a verdict for the nonmoving party. *Id.*

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16 Where the moving party will have the burden of proof at
17 trial, it must demonstrate that no reasonable trier of fact
18 could find other than for the moving party. *Soremekun v.*
19 *Thrifty Payless, Inc.*, 509 F.3d 978, 984 (9th Cir.2007). Where
20 the nonmoving party will bear the burden of proof at trial,
21 the moving party can prevail merely by pointing out to the
22 district court that there is an absence of evidence to support
23 the nonmoving party's case. *Celotex*, 477 U.S. at 324-25, 106
24 S.Ct. 2548. If the moving party meets its initial burden, the
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1 opposing party must then set out specific facts showing a
2 genuine issue for trial in order to defeat the motion.
3 *Anderson*, 477 U.S. at 250, 106 S.Ct. 2505; see also
4 Fed.R.Civ.P. 56(c), (e).
5

6 When deciding a summary judgment motion, a court must view
7 the evidence in the light most favorable to the nonmoving
8 party and draw all justifiable inferences in its favor.
9 *Anderson*, 477 U.S. at 255, 106 S.Ct. 2505; *Hunt v. City of Los*
10 *Angeles*, 638 F.3d 703, 709 (9th Cir.2011). It is not enough
11 for a party opposing summary judgment to "rest on mere
12 allegations or denials of his pleadings." *Anderson*, 477 U.S.
13 at 259. Instead, the nonmoving party must go beyond the
14 pleadings to designate specific facts showing that there is a
15 genuine issue for trial. *Celotex*, 477 U.S. at 325.
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18 It is not the Court's task "to scour the record in search
19 of a genuine issue of triable fact." *Keenan v. Allan*, 91 F.3d
20 1275, 1279 (9th Cir.1996). Counsel has an obligation to
21 clearly lay out support for the claim asserted. *Carmen v. San*
22 *Francisco Unified Sch. Dist.*, 237 F.3d 1026, 1031 (9th
23 Cir.2001). The Court "need not examine the entire file for
24 evidence establishing a genuine issue of fact, where the
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1 evidence is not set forth in the opposing papers with adequate
2 references so that it could conveniently be found." *Id.*

3 **C. Gonzaga's Motion for [Partial] Summary Judgment**

4 **1. Gonzaga's Identifiers and Marks**

5 Plaintiff Gonzaga, is an institution of higher learning in
6 Spokane, Washington and has become well-known for its athletic
7 programs in the Spokane area. The following are the "words,
8 terms, names, symbols, devices, and combinations thereof"
9 (hereinafter referred to as Identifiers and Marks) that
10 Gonzaga asserts were used by the Defendants to reference or
11 identify Gonzaga in connection with Defendants' commercial and
12 promotional purposes:
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16 "GONZAGA UNIVERSITY", which is the subject of
17 U.S. Trademark Registration No. 1,931,286,
18 and is an incontestable U.S. trademark per 15
19 U.S.C. §1065. ECF No. 23.

20 "GONZAGA UNIVERSITY BULLDOGS", which is the
21 subject of U.S. Trademark Registration No.
22 1,931,285, and is an incontestable U.S.
23 trademark per 15 U.S.C. §1065. *Id.*

24 "ZAGS", which is the subject of U.S.
25 Trademark Registration No. 1,931,449, and is
26 an incontestable U.S. trademark per 15 U.S.C.
§1065. *Id.*

/ / /

1 **Gonzaga's "Bulldog mascot wearing a Gonzaga**
2 **jersey"**, which the record indicates that
3 Gonzaga has used in Spokane since the 1980's,
4 and which is the subject of Washington State
Trademark Registration File No. 56807. *Id.*

5 **Gonzaga's Bulldog Head**, for which Gonzaga has
6 been awarded Washington State Trademark
7 Registration File No. 56780, showing a date
of first use in Washington in 1998. *Id.*

8 **Gonzaga's Bulldog Head combined with the word**
9 **Gonzaga**, for which Gonzaga has been awarded
10 Washington State Trademark Registration File
11 No. 56959, showing a date of first use in
Washington in 1998. *Id.*

12 Gonzaga's Identifier **"GU"**, for which Gonzaga
13 has been awarded Washington State Trademark
14 Registration File No. 56960, showing a date
of first use in Washington in 1998. *Id.*

15 **Gonzaga's Bulldog Head combined with "GU"**,
16 for which Gonzaga has been awarded Washington
17 State Trademark Registration File No. 56958,
18 showing a date of first use in Washington in
1998. *Id.*

19 **2. The Undisputed Facts Underlying the Section 43(a)** 20 **Claim**

21 The controlling facts of the case at bar are relatively
22 uncomplicated and uncontested. Plaintiff Gonzaga has a rather
23 well-known basketball team in the Spokane area and throughout
24 the State of Washington. ECF No. 24. In producing and
25 promoting the sport of NCAA basketball, Gonzaga has adopted
26

1 and widely publicized the name/nickname (GONZAGA UNIVERSITY,
2 GONZAGA UNIVERSITY BULLDOGS, ZAGS) and a team symbol, Spike,
3 a bulldog who wears a Gonzaga jersey. Since the 1998-1999
4 season when Gonzaga began to enjoy national prominence and
5 using the Gonzaga Identifiers and Marks, thousands of fans
6 have attended basketball games where the team Identifiers and
7 Marks are displayed on jersey fronts of the players, bulldog
8 mascot and throughout the game programs. Other fans observe
9 the team Identifiers and Marks during televised games. Still
10 more fans are exposed to Gonzaga's Identifiers and Marks
11 through sporting news coverage in newspapers, magazines, and
12 radio.
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16 Gonzaga alleges that Defendants have used the bulldog
17 mascot wearing a Gonzaga jersey, a bulldog mascot head with a
18 spike collar and other Gonzaga Identifiers and Marks in
19 conjunction with their radio station services and bar services
20 intending the consuming public to recognize the Gonzaga
21 Identifiers as symbols of Gonzaga.
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24 Photographs of these uses were posted in commerce on
25 Defendants' online social media websites which advertise and
26 promote Defendants' radio station and bar services. ECF No.

1 22 at 7-26. Relative to the Spokane Downtown Daiquiri
2 Factory, Gonzaga asserts that the use of a bulldog mascot
3 wearing a Gonzaga-identifying jersey (Gonzaga or GU), as well
4 as the posting of photographs on Defendants' online social
5 media websites, were intended to reference or identify Gonzaga
6 in connection with the commercial advertising and promotion of
7 defendants' bar services, the Spokane Downtown Daiquiri
8 Factory.
9
10

11 Gonzaga asserts that the Defendants' use of the Gonzaga
12 Identifiers and Marks is likely to cause confusion, or to
13 cause mistake, or to deceive as to the affiliation,
14 connection, or association of Gonzaga with the radio station
15 and bar services offered by Defendants' businesses, or as to
16 the origin, sponsorship, or approval of Defendants' radio
17 station and bar services, or commercial activities.
18
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20 With regard to the radio station services, Gonzaga argues
21 that the photographs make it appear that the third party
22 businesses being promoted and/or Pendleton Broadcasting's
23 104.5 radio station are affiliated with, associated with or in
24 some other commercial business relationship with Gonzaga.
25

26 Gonzaga reports there have been multiple instances of

1 actual confusion by members of the public in Spokane as to
2 whether there was an "affiliation, connection, or association"
3 or a "sponsorship, or approval" between Defendants and
4 Gonzaga. One such example of this reported association
5 (negative) with one of Defendants' businesses, the Downtown
6 Spokane Daiquiri Factory, is as follows:
7

8
9 **> Dear GU Athletics - As a Spokane resident,**
10 **a mother of student athletes and fan of GU -**
11 **I was very dismayed to see Spike associated**
12 **in this manner with this particular business.**
13 **This bar has promoted their signature drink**
14 **called Date Grape, an obvious pun on Date**
15 **Rape, and refuses to cooperate, acknowledge,**
16 **or show any remorse for their blatant**
17 **insensitivity for victims of sexual assault.**
18 **This issue has prompted nationwide press**
19 **coverage and as a result, they simply put the**
20 **word "Banned" over the word Date. They are**
21 **now promoting their "Q-Laid", "Strawberry**
22 **Deep Throat Banana" and "We Still In This**
23 **Bitch". See below as well as the numerous**
24 **pictures still showing of Spike in their**
25 **public photo gallery.**

26 **>**

> I do not know if you are aware of this or
not, the pictures are in their photo gallery
on a public page and this is not a good image
for your mascot. Thank you.

ECF No. 24, Kassel Decl., ¶ 10.

Gonzaga (through its Associate Athletic Director
Kristopher Kassel) requested that Defendant Pendleton cease

1 further use of the Gonzaga Identifiers and Marks, but the uses
2 did not stop. Gonzaga concludes that Defendants are using
3 Gonzaga's Identifiers and Marks without authorization and such
4 uses make it appear that there is an affiliation with,
5 association with or some other commercial business
6 relationship with Gonzaga-- when there is none.
7

8 **3. Defendants' Opposition**

9
10 Defendants oppose the motion arguing that in a trademark
11 action, likelihood of confusion is a material fact² which
12 should preclude summary judgment. Defendants do not respond to
13 Plaintiff's argument that there is a likelihood of confusion
14 with their use of Gonzaga's Identifier and Marks. Defendants,
15 despite there being no affidavits containing contrary facts,
16 assert there exist genuine issues of fact, yet to be resolved.
17 Additionally, Defendants argue that the parties have yet to
18 commence any discovery.
19
20

21 Defendants further argue that the doctrine of "fair use"
22 should be held applicable to this trademark infringement
23 action and that the Court should apply the doctrine to
24

25
26 ²Defendants cite *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993).

1 sanction their use of a replica of Gonzaga's Identifiers.
2 Plaintiff replies that Defendants do not mount a colorable
3 factual or legal argument why their use of Gonzaga's
4 Identifiers and Marks is a "fair use" or what facts they need
5 from the discovery process to support this or any of their
6 contentions.
7

8
9 Another issue advanced by Defendants is whether a mark
10 owned by the Plaintiff can be protected outside of the class
11 of services for which it is registered. Plaintiff replies
12 that all trademarks can apply outside of the "class" of
13 services because the legal test for trademark infringement is
14 whether there is a likelihood of confusion. The Court finds
15 it unnecessary to decide this issue as this motion only covers
16 a claim pursuant to §43(a) of the Lanham Act for unregistered
17 marks.
18
19

20 Defendants also assert that the Washington State
21 trademarks were obtained after this suit was filed. Plaintiff
22 replies that the Washington State trademarks each certify that
23 the marks are trademarks owned by Gonzaga, carry the
24 evidentiary value set forth in R.C.W. §19.77.040, and identify
25 Gonzaga as the source of the goods. Again, this motion does
26

1 not cover state registered trademark infringement.

2 Finally, Defendants suggest that Gonzaga does not have
3 standing to bring suit.
4

5 **D. Section 43(a) Violation - Likelihood of Confusion Analysis**

6 In its Complaint, Gonzaga claims that Defendants are
7 liable for trademark infringement and unfair competition under
8 the Lanham Act, 15 U.S.C. §1125(a). Gonzaga indicated at the
9 hearing that the instant motion for summary judgment was based
10 only on Section §43(a) of the Lanham Act (15 U.S.C. §1125(a)).
11 Although it is somewhat unclear, Gonzaga's arguments cover
12 claims of false designation of origin, federal/common law
13 trademark infringement (collectively, "infringement claims"),
14 and unfair competition claims, which claims cannot be
15 separated for purposes of the Court's analysis. Section 43(a)
16 covers unregistered marks and is the federal counterpart of
17 certain state unfair competition and anti-dilution rights.
18

19 Section 43(a) of the Lanham Act gives an entity a cause of
20 action for the use by any person of "any word, term, name,
21 symbol, or device, or any combination thereof * * * which * *
22 * is likely to cause confusion * * * as to origin,
23 sponsorship, or approval of his or her goods." 15 U.S.C. §
24
25
26

1 1125(a).

2 In order to sue under the statute at issue in the instant
3 motion, it is not necessary for a mark or trademark to be
4 registered. *New West Corp. v. NYM Co. of California, Inc.*,
5 595 F.2d 1194, 1198 (9th Cir. 1979). Whether the theory is
6 Section 43(a) of the Lanham Act or state unfair competition
7 law,³ the ultimate test is whether the public is likely to be
8 deceived or confused by the similarity of the marks. *Id.* at
9 1201. The burden on plaintiff is twofold: First, plaintiff
10 must establish secondary meaning in their use of the Gonzaga
11 Identifiers and Marks. Second, Defendants' activities must be
12 shown to have created a likelihood of confusion.
13

14 Secondary meaning has been defined as association, nothing
15 more. *Carter-Wallace, Inc. v. Proctor & Gamble Co.*, 434 F.2d
16 794, 802 (9th Cir. 1970). The basic element of secondary
17 meaning is a mental recognition in buyers' and potential
18 buyers' minds that products connected with the symbol or
19 device emanate from or are associated with the same source.
20
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25 ³Plaintiff's Fourth Cause of Action is for common law
26 unfair competition but was not specifically argued in the
summary judgment motion.

1 *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 200
2 U.S.P.Q. 713, 716 (9th Cir. 1980).

3
4 The creation of confusion as to sponsorship of products
5 is also actionable. See *HMH Publishing Co., Inc. v. Brincat*,
6 504 F.2d 713, 716 (9th Cir. 1974); *Dallas Cowboys Cheerleaders,*
7 *Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2nd Cir.
8 1979). The standard, however, applied by the courts in
9 determining whether a showing of secondary meaning has been
10 made in a sponsorship context is not well-defined. See, e.g.,
11 *HMH Publishing*, 504 F.2d at 718 (secondary meaning is
12 demonstrated by a showing that the purchasing public generally
13 believes that a product which bears that mark is "in some
14 fashion connected" with the products of the registrant); *Wyatt*
15 *Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F.Supp. 621, 625
16 (S.D.N.Y.1958) (collapsing the analysis of likelihood of
17 confusion and secondary meaning).

18
19 The correct standard should be reachable deductively.
20
21 *National Football League Properties, Inc. v. Wichita Falls*
22 *Sportswear*, 532 F.Supp. 651, 659 (D.C.Wash.1982). There is
23
24 a symmetry between the concepts of secondary meaning and
25
26 likelihood of confusion. Secondary meaning requires an

1 examination of the non-infringing party's mark and product,
2 and tests the connection in the buyers' mind between the
3 product bearing the mark and its source. *Id.* Likelihood of
4 confusion in a sponsorship context focuses on the product
5 bearing the allegedly infringing marks and asks whether the
6 public believes the product bearing the marks originates with
7 or is somehow endorsed or authorized by the plaintiff. *Id.*
8 *citing Kentucky Fried Chicken Corp. v. Diversified Packaging*
9 *Corp.*, 549 F.2d 368, 388-90 (5th Cir. 1977). Just as the
10 relevant inquiry for the establishment of likelihood of
11 confusion in a sponsorship context is the belief that
12 sponsorship or authorization was granted, the inquiry should
13 be the same in order to establish secondary meaning. *Wichita*,
14 532 F.Supp. at 659.

15
16 As the Ninth Circuit has explained it, § 43(a) provides
17 two bases for liability: "(1) false representations concerning
18 the origin, association or endorsement of goods or services
19 through the wrongful use of another's distinctive mark, name,
20 trade dress or other device ('false association'), and (2)
21 false representations in advertising concerning the qualities
22 of goods or services ('false advertising')." *Waits v.*

1 *Frito-Lay, Inc.*, 978 F.2d 1093, 1108 (9th Cir.1992) (citations
2 omitted). Here, Plaintiff asserts a violation of the Lanham
3 Act §1025 [sic] as its First Claim for relief. ECF No. 1 at 8.

4
5 A false endorsement claim is available where defendants'
6 conduct has allegedly created "a likelihood of confusion as to
7 whether plaintiffs were endorsing [defendants'] product."
8 *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 812 (9th Cir.1997).

9
10 "Section 43(a)(1) [of the Lanham Act] provides similar
11 protection to trademarks regardless of registration." *Bell v.*
12 *Harley Davidson Motor Co.*, 539 F.Supp.2d 1249, 1254
13 (S.D.Cal.2008) (citing *Brookfield Commc'ns, Inc. v. W. Coast*
14 *Entm't Corp.*, 174 F.3d 1036, 1046 n. 6 (9th Cir.1999)). "To
15 establish a trademark infringement claim ..., [Plaintiff] must
16 establish that [Defendant] is using a mark confusingly similar
17 to a valid, protectable trademark of [Plaintiff's]."
18 *Brookfield Commc'ns*, 174 F.3d at 1046. "To show that he has a
19 protectable trademark interest, Plaintiff must have been the
20 first to use the mark in the sale of goods or services."
21 *Sengoku Works, Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1219 (9th
22 Cir.1996).

1 To prevail on an infringement claim, a trademark owner⁴
2 must prove that the alleged infringer used the mark at issue
3 in commerce and in connection with the sale, distribution, or
4 advertising of goods or services in such a way that the use
5 "is likely to cause confusion, or to cause mistake, or to
6 deceive." 15 U.S.C. § 1114; see also 15 U.S.C. § 1125(a).
7
8 Infringement disputes are "intensely factual in nature," and
9 therefore summary judgments are generally disfavored.
10 *Interstellar Starship Serv., Ltd. v. Epix, Inc.*, 184 F.3d
11 1107, 1109 (9th Cir.1999).
12

13
14 As between Plaintiff and Defendants, this Court finds
15 Plaintiff is the owner of the Gonzaga Identifiers and Marks,
16 which include protectable marks.⁵ Defendants have not denied
17

18 ⁴Although Defendants assert an affirmative defense calling
19 into question the ownership of the marks, there is no dispute
20 that Gonzaga owns the Marks, which are federally and state
21 registered or acquired through actual and continuous use. (ECF
22 No. 22, Hendricksen Decl., ¶¶ 2-5.) This "constitutes prima
23 facie evidence of the validity of the registered mark and of
24 [Gonzaga's] exclusive right to use the mark on the goods and
25 services specified in the registration." *Brookfield*, 174 F.3d
26 at 1047.

27 ⁵Three word marks are incontestible federal trademarks
28 ("GONZAGA UNIVERSITY," GONZAGA UNIVERSITY BULLDOGS, and
29 "ZAGS"). Plaintiff may also prevail if it establishes that it
30 has a common law trademark or service mark. See *Boston*

1 that each of the Gonzaga Identifiers or trademarks refer to or
2 identify Gonzaga in the Spokane area. With the exception of
3 other non-local teams that also use a bulldog mascot,
4 Defendants have not identified any other possible entity to
5 which the Gonzaga Identifiers and Marks refer.
6

7 The Court finds that Defendants have made commercial use
8 of a mark that is similar enough to cause confusion in the
9 minds of consumers about the origin of the goods or services
10 in question. *KP Permanent Make-Up, Inc. v. Lasting Impression*
11 *I, Inc.*, 543 U.S. 111, 117, 125 S.Ct. 542, 160 L.Ed.2d 440
12 (2004).
13
14

15 To assess likelihood of confusion, courts in the Ninth
16 Circuit consider the *Sleekcraft* factors:

- 17 (1) the strength of the plaintiff's mark;
18 (2) relatedness of the goods;
19 (3) similarity of the marks;
20 (4) evidence of actual confusion;
21 (5) marketing channels used;
22 (6) likely degree of purchaser care;
23 (7) defendant's intent in selecting the mark; and
24 (8) likelihood of expansion of the product lines.
25 *Wendt*, 125 F.3d at 812 (applying *AMF, Inc. v. Sleekcraft*

25 *Professional Hockey Association v. Dallas Cap & Emblem Mfg.,*
26 *Inc.*, 510 F.2d 1004, 1010 (5th Cir.), Cert. denied, 423 U.S.
991, 96 S.Ct. 408, 46 L.Ed.2d 312 (1975).

1 *Boats*, 599 F.2d 341 (9th Cir.1979)). This list of factors is
2 not exhaustive and is not intended to be applied as a
3 "mechanistic formula." *Dr. Seuss Enterprises, L.P. v. Penguin*
4 *Books USA, Inc.*, 109 F.3d 1394, 1404 (citations and internal
5 marks omitted), *cert. dismissed*, *Penguin Books USA, Inc. v.*
6 *Dr. Seuss Enterprises*, 521 U.S. 1146, 118 S.Ct. 27, 138
7 L.Ed.2d 1057 (1997). "Other variables may come into play
8 depending on the particular facts presented." *Id.* As the
9 nature of the factors makes clear, the " 'likelihood of
10 confusion' standard is predominantly factual in nature." *Id.*
11
12
13

14 In the Spokane area, there is no dispute that Gonzaga's
15 Identifiers and Marks are commercially strong. The
16 relatedness of goods/services is somewhat nebulous as one
17 could argue that an athletic/school program class is not close
18 to the Defendants' bar/radio program class, but Gonzaga
19 arguably has opportunities to associate with or approve of a
20 broad range of different entities to become affiliated with
21 its programs. In this case, there can be no dispute that
22 Defendants are using Gonzaga's Identifiers and Marks
23 identically except the bulldog mascot wearing the Gonzaga
24 identifying jersey. Even though the bulldog costume is
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26

1 different than Gonzaga's, the bulldog costume also includes
2 other Gonzaga Identifiers to further create the impression
3 that it is the Gonzaga Bulldog mascot or is affiliated or
4 approved by Gonzaga.
5

6 Evidence of actual confusion is not required to find a
7 likelihood of confusion. Moreover, if Plaintiff offers
8 compelling evidence of actual confusion, such evidence may be
9 "persuasive proof that future confusion is likely." *SunEarth,*
10 *Inc., v. Sun Earth Solar Power Co.*, 846 F.Supp.2d 1063, 1079
11 (N.D.Cal.2012) (citations and quotations omitted). The Court
12 finds that Defendants have used Gonzaga's Identifiers to
13 benefit from any connection (negative or positive) the public
14 might draw between the well-know sports team (and its
15 goodwill)and Defendants' sports bar or radio station.
16 Plaintiff has also provided compelling evidence of the
17 existence of at least public comment and confusion from the
18 use of the Spike-like mascot at the Spokane Daiquiri Factory.
19
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21

22 As far as marketing channels go, in this case both Gonzaga
23 and the Defendants advertise and promote their respective
24 goods and services to the public in Spokane, Washington using
25 the Gonzaga Identifiers and Marks. From the photographs
26

1 included in Exhibit B to the Kassel Declaration, the
2 Defendants have been using their bulldog mascot with the
3 Gonzaga or GU jersey in the promotion of Defendants'
4 businesses (as well as the businesses of the customers of
5 Defendant's radio station 104.5 JAMZ) in the Spokane area.
6 Furthermore, when it comes to well-known college sports
7 programs, the range of businesses and products with which the
8 college may become associated or approve is wide and varied.
9

10
11 The Spokane area has a very large number of Gonzaga fans
12 who are loyal to Gonzaga and its various athletic teams, and
13 based upon the photographs attached as Exhibit B to the Kassel
14 Declaration, Defendants are using Gonzaga's Identifiers and
15 Marks in order to benefit commercially from the well known fan
16 recognition and loyalty.
17

18
19 The fact that the Defendants are using several of
20 Gonzaga's Identifiers and Marks in most instances, is strong
21 evidence that Defendants are intending to create the
22 impression that Defendants are affiliated, connected or
23 associated with Gonzaga, or that there was a sponsorship or
24 approval of Defendants goods, services, or commercial
25 activities by Gonzaga. Evidence would suggest Defendants are
26

1 intending to use the notoriety and reputation of Gonzaga to
2 gain attention, advertising and benefit in Defendants' own
3 businesses, and in the case of Defendants' radio station
4 (104.5 JAMZ), promotional benefit for the third party
5 businesses.
6

7 As far as the other remaining Sleekcraft factors, these
8 either favor Gonzaga or are neutral.
9

10 To address Defendants' defense of fair use raised in their
11 opposition, the fair use doctrine typically allows adjustments
12 of conflicts between the first amendment and the copyright
13 laws, *See Wainwright Securities Inc. v. Wall Street Transcript*
14 *Corp.*, 558 F.2d 91, 95 (2d Cir. 1977), Cert. denied, 434 U.S.
15 1014, 98 S.Ct. 730, 54 L.Ed.2d 759 (1978), and is designed
16 primarily to balance "the exclusive rights of a copyright
17 holder with the public's interest in dissemination of
18 information affecting areas of universal concern, such as art,
19 science and industry." *Id.* at 94.
20
21

22 There are two fair use defenses available in trade dress
23 or trademark infringement cases—classic and nominative. The
24 classic fair use defense "applies only to marks that possess
25 both a primary meaning and a secondary meaning—and only when
26

1 the mark is used in its primary descriptive sense rather than
2 its secondary trademark sense." *Brother Records, Inc. v.*
3 *Jardine*, 318 F.3d 900, 905 (9th Cir.2003). In the Ninth
4 Circuit, "the classic fair use defense is not available if
5 there is a likelihood of customer confusion as to the origin
6 of the product." *Cairns v. Franklin Mint*, 292 F.3d 1139, 1151
7 (9th Cir.2002).
8
9

10 To prove nominative fair use, a defendant must satisfy
11 three requirements: (1) "the plaintiff's product or service in
12 question must be one not readily identifiable without use of
13 the trademark"; (2) "only so much of the mark or marks may be
14 used as is reasonably necessary to identify the plaintiff's
15 product or service"; and (3) "the user must do nothing that
16 would, in conjunction with the mark, suggest sponsorship or
17 endorsement by the trademark holder." *Mattel, Inc. v. Walking*
18 *Mountain Productions*, 353 F.3d 792, 809 (9th Cir.2003).
19
20

21 The Court does not find either type of fair use is
22 applicable under the facts of this case. There are numerous
23 ways in which Defendants may entertain their Gonzaga fans
24 without infringing Plaintiff's trademark(s). Because the
25 primary purpose of the trademark laws is to protect the public
26

1 from confusion,⁶ it would be somewhat anomalous to hold that
2 the confusing use of another's trademark is "fair use". See
3 also *Truck Equipment Service Co. v. Fruehauf Corp.*, 536 F.2d
4 1210, 1215 (8th Cir.), Cert. denied, 429 U.S. 861, 97 S.Ct.
5 164, 50 L.Ed.2d 139 (1976).

7 The greater the similarity, the greater the likelihood of
8 confusion. *GoTo.com. Inc. v. Walt Disney Co.*, 202 F.3d 1199,
9 1205-06 (9th Cir.2000). In the Ninth Circuit, secondary meaning
10 is defined merely as "association" and has as its "basic
11 element ... the mental association by a substantial segment of
12 consumers and potential consumers 'between the alleged mark
13 and a single source of the product.'" *Levi Strauss & Co.*, 778
14 F.2d at 1354, quoting McCarthy, §§ 15:2 and 15:11(B)
15 (additional citations omitted).

16 "[W]hile the issue of likelihood of confusion is a mixed
17 question of law and fact, the inquiry is predominantly a
18 question of fact." *United States v. Six Thousand Ninety-Four*
19 *(6,094) "Gecko" Swimming Trunks*, 949 F.Supp. 768, 771
20 (D.Haw.1996). The circumstances of each particular case
21

22
23
24
25
26 ⁶, See *W. E. Basset Co. v. Revlon, Inc.*, 354 F.2d 868, 871
(2d Cir. 1966).

1 dictate whether the determination is a question of law or
2 fact. *J.B. Williams Company, Inc. v. Le Conte Cosmetics, Inc.*,
3 523 F.2d 187, 190 (9th Cir.1975). Where summary judgment is
4 appropriate, however, injunctive relief is the remedy of
5 choice. *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d
6 1175, 1180 (9th Cir.1988). Gonzaga indicated at the hearing
7 that if its summary judgment is granted, it will moved for
8 injunctive relief in a motion to follow.
9

11 Plaintiff has put forth evidence to establish secondary
12 meaning for its Identifiers and Marks and the likelihood of
13 confusion, relative to Defendants' use of the various
14 Identifiers/Marks and combinations thereof. Plaintiff has
15 shown the primary significance of its Identifiers and Marks is
16 source identification.
17

18 Having found that Plaintiff has acquired secondary meaning
19 in its Identifiers including the bulldog (with spike collar
20 wearing a Gonzaga jersey), the Court finds that the bulldog
21 mascot used by Defendants in the Spokane area closely
22 resembles Gonzaga's bulldog mascot and that the public is
23 likely to identify it as Plaintiff's mascot.
24

26 In the Complaint, Plaintiff states that "[i]n the past

1 weeks for example, multiple concerned citizens have voiced
2 a concern or outrage that Gonzaga University would be
3 affiliated or associated with a business that would engage in
4 conduct such as naming a drink Date Grape Koolaid." ECF No.
5 1 at 8. As Judge Markey opined, the trademark laws are
6 designed not only to prevent consumer confusion but also to
7 protect "the synonymous right of a trademark owner to control
8 his product's reputation." *James Burrough Ltd. v. Sign of the*
9 *Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976). The
10 depiction of the bulldog in a Gonzaga jersey using a urinal as
11 shown in the March 23, 2013 posting on Defendants' social
12 media advertising website, for example, violates §43(a) and
13 the Plaintiff's right to control its reputation. (ECF. No. 22
14 at 21).

15 In the Ninth Circuit, neither an intent to confuse nor
16 actual confusion are required elements of a trademark
17 infringement claim. See *Coca-Cola Co. v. Overland, Inc.*, 692
18 F.2d 1250, 1256 n. 16 (9th Cir.1982) (intent to confuse);
19 *Brookfield Communications, Inc. v. West Coast Entm't Corp.*,
20 174 F.3d 1036, 1050 (9th Cir.1999) (actual confusion).
21 Instead, "[l]ikelihood of confusion will be found whenever

1 consumers are likely to assume that a mark is associated with
2 another source or sponsor because of similarities between the
3 two marks." *Academy of Motion Picture Arts & Scis. v. Creative*
4 *House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir.1991),
5 *citing Shakey's, Inc. v. Covalt*, 704 F.2d 426, 431 (9th
6 Cir.1983).

7
8 Defendants, as the nonmoving parties, have not designated
9 specific facts showing that there is a genuine issue(s) for
10 trial with respect to Plaintiff's §43(a) claim. The Court
11 finds, as a matter of law, evidence of record would permit a
12 rational factfinder to conclude Defendants' use of the Gonzaga
13 Identifiers and Marks is likely to cause confusion, or to
14 cause mistake, or to deceive as to the affiliation,
15 connection, or association of Gonzaga with the radio station
16 and bar services offered by Defendants' businesses, or as to
17 the origin, sponsorship, or approval of Defendants' radio
18 station and bar services, or other commercial activities.

19
20 As to Defendants' defense that Plaintiff lacks standing,
21 the Court flatly rejects this contention. On its face,
22 Section 43(a) gives standing to sue to "any person who
23 believes that he is or is likely to be damaged." See *L'Aiglon*

1 *Apparel Co. V. Lana Lobell, Inc.*, 214 F.2d 649 (3rd Cir.1954).

2 **E. Conclusion**

3
4 Accordingly, the Court finds the likelihood of confusion
5 exists and a violation of Section 43(a) has occurred. The
6 strength in the market of Plaintiff's Identifiers weigh in
7 favor of finding likelihood of confusion required for
8 Gonzaga's Lanham Act false designation of origin claim against
9 Defendants as supported by Gonzaga's long and substantial use
10 of the Identifiers and marks in connection with the college
11 and well-known athletic program.
12

13
14 Accordingly, Plaintiff Gonzaga's Motion for [Partial]
15 Summary Judgment, **ECF No. 21**, is **GRANTED**. The Court
16 specifically finds for Plaintiff with respect to the First
17 Cause of Action (Violation of the Lanham Act, Section 43(a)).
18

19 The District Court Executive is directed to enter this
20 Order.

21 **DATED** this 25th day of September, 2014.

22
23 ***s/Lonny R. Suko***

24
25 _____
26 LONNY R. SUKO
SENIOR UNITED STATES DISTRICT JUDGE